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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,752	10/30/2003	Lawrence D. Bergman	YOR920030395US1	8753
<div>7590 02/26/2008 Robert W. Griffith Ryan, Mason &amp; Lewis, LLP 90 Forest Avenue Locust Valley, NY 11560</div>			<div>EXAMINER DAO, THUY CHAN</div>	
			<div>ART UNIT 2192</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 02/26/2008</div>	<div>DELIVERY MODE PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/697,752

Applicant(s)

BERGMAN ET AL.

Examiner

Thuy Dao

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**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on January 15, 2008 has been entered.

2. Claims 29-36 have been examined.

### **Response to Amendments**

3. Per Applicants' request, claims 29 and 36 have been amended.
4. The objection to the specification is withdrawn in view of Applicants' amendments.

### **Response to Arguments**

5. Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.

### **Claim Rejections – 35 USC § 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 36 is rejected because the claimed invention is directed to non-statutory subject matter. Claim 36 directs to an article of manufacture, which does not exclude a software computer program as disclosed in the specification, page 4, lines 1-7.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such

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claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. See MPEP 2106.

Under the principles of compact prosecution, claim 36 has been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC § 101 issues. For example (proposal only), - -An article of manufacture, stored in a memory, for customizing ...- - as disclosed in the specification, page 11, lines 22-24.

### **Claim Rejections – 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by "Mixed Initiative Interfaces for Learning Tasks: SMARTedit Talks Back" to Wolfman et al. (art made of record, hereinafter "Wolfman").

**Claim 29:**

Wolfman discloses an article for manufacture and *an apparatus for customizing a control of a user-interface of an existing application comprising:*

*a memory; and at least one processor (e.g., col.3: 42 – col.4: 28), coupled to the memory operative to:*

*(i) record a procedure description comprising a series of actions performed by a user (e.g., col.4: 29-34; col.4: 47 - col.5: 26; col.12: 56 - col.13: 6)*

*in the application user-interface (e.g., col.4: 28 – col.5: 27; FIG. 2 at col.5); and*

*(ii) install a user-interface control relating to the procedure description in the existing application (e.g., col.13: 22-37; FIG. 4, col.12: 38 – col.13: 6)*

*for automatic execution of the procedure description and generation of the series of actions performed by the user when the user-interface control is activated (e.g., col.13: 7-27; col.1: 1-28; col.4: 59 – col.5: 26).*

**Claim 30:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of recording a procedure description performed by a user in the application user-interface comprises the steps of: transmitting at least one request for application user-interface structure information from a procedure capturer to an operating system (e.g., col.7: 40 – col.8 ;30); and*

*receiving the application user-interface structure information from the operating system at the procedure capturer (e.g., FIG.4, col.12: 38 – col.13: 21).*

**Claim 31:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of recording a procedure description performed by the user in the application user-interface comprises the step of registering the procedure capturer with the operating system to receive notification of user actions and system actions (e.g., col.5: 27-54).*

**Claim 32:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of recording a procedure description performed by the user in the application user-interface comprises the steps of: receiving notification of user action within the application interface at the procedure capturer; determining a result activated by user action at the procedure capturer; mapping the activated control into a generic description at the procedure capturer (e.g., FIG. 2, col.4: 59 – col.5: 54);*

*adding the generic description to a procedure representation at the procedure capturer; determining if there are more user actions; and storing the procedure representation in the procedure capturer if there are no more user actions (e.g., FIG. 4,col.11: 3 – col.12: 35).*

**Claim 33:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of installing the control relating to the procedure description in the existing application comprises the steps of: sending a request to an operating system from a control installer to install the control (e.g., col.6: 37 – col.7: 7);*

*creating and installing the control in the application user-interface through the operating system; and registering a callback at the operating system using a location supplied by the control installer (e.g., col.13: 22 – col.14: 14).*

**Claim 34:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the at least one processor is further operative to execute an installed control* (e.g., col.13: 6-21).

**Claim 35:**

The rejection of claim 29 is incorporated. Wolfman also discloses *the operation of installing the user- interface control comprises the step of altering the appearance of at least one existing user interface control* (e.g., FIG. 4, col.12: 38 – col.13: 5).

**Claim 36:**

Claim 36 is an article of manufacture version, which recites the same limitations as those of claim 29, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the reference teaches all of the limitations of the above claim, it also teaches all of the limitations of claim 36.

**Conclusion**

10. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.


Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. Dao



TUAN DAM  
SUPERVISORY PATENT EXAMINER